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EXAMINER
EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
2153	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,957

Applicant(s)

CHAN, WILSON J.

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-12,14,15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12,14,15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 6.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to Applicant's amendment filed on October 8, 2003. Claims 1-6, 8-12, 14, 15, and 17 are presented for further examination. Although Examiner had objected to certain dependent claims in the previous Office action as containing allowable subject matter, these claims are now rejected in view of further consideration regarding claim language and claim interpretation. For this reason, this Office action is non-final.

Examiner had spoken with Applicant's representative on October 21, 2003 regarding a potential Examiner's amendment to overcome a 35 USC 112, second paragraph rejection and to place the case in condition for allowance. However, because of the new grounds for rejection, the proposed amendment was not entered.

Note: The terms "media switch matrix" and "media interface device control repeater" are not normal terms of art used in either the computer networking or the music industries (Examiner retrieved zero search hits when entering these terms into either Google.com or the U.S. Patent database). The terms appear in the claims, and are defined in the claims only with regard to their function. Therefore, the terms as used in the claims are interpreted only with regard to their function. The specification describes the media switch matrix as including "a plurality of rows of wires 29, a plurality of columns of wires 41, inputs 63 from host computers 18 and processors in media processing hardware and software 22, outputs 53 to host computers 18 and processors in media processing hardware and software 22, and switch controls." See p. 6, lines

30-34. Nonetheless, any computer system includes these features. The "media device control repeater" is described in the specification only in terms of its functionality. Thus, because this description gives no definitive details distinguishing the "media switch matrix" from any other general network computing device, and because the specification describes the "media device control repeater" only with respect to its functionality, only the functions of the "media switch matrix" and "media interface device control repeater," as defined in the claims themselves, are considered.

Thus, the "media switch matrix for routing the media file to said modifying [means]," as claimed in claim 1 is interpreted as "means for routing the media file to said modifying means." Likewise, the "media interface device control repeater for selecting one of a predetermined plurality of modifications to be performed by said modifying means," as claimed in claim 1 is interpreted as "means for selecting one of a predetermined plurality of modifications to be performed by said modifying means."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 2, 5, 8-12, 14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Clynes (U.S. Patent No. 5,590,282).

In considering claim 1, Clynes discloses a system comprising:

A memory for storing a media file (central storage); a host computer (central computer station 10); and a personal communication device (subscriber post), said personal communication device having access to said memory and said personal communication device being adapted to transmit the media file to said host computer (col. 5, lines 10-20; col. 6, lines 40-41, wherein the user creates the microscore and sends it to the central station to be stored);

Means accessible to said host computer for modifying the media file (col. 5, lines 62-67);

Means for storing the modified media file (col. 6, lines 1-5).

Means for routing the media file to the modifying means (col. 5, line 62 – col. 6, line 6, wherein the routing means are inherent when the score is stored at the central station and sent to the subscriber post to be modified); and

Means for selecting one of a predetermined plurality of modifications to be performed by the modifying means (col. 5, lines 20-60, pulse, tempo, dynamics, etc.).

In considering claim 2, Clynes further discloses that the host computer is adapted to transmit information to the personal communication device (col. 6, lines 30-31).

In considering claims 5, Clynes further discloses that the host computer is adapted to receive a media file that is any of a plurality of predetermined formats (i.e. video, audio, music notation, as described below).

In considering claim 8, Clynes further discloses that the means for selecting a modification comprises receiving a control signal from said host computer and means for sending multiple outputs to the modifying means (col. 5, line 10 – col. 6, line 6, wherein the host computer sends the score to the modification means at the subscriber station, wherein the score includes multiple outputs).

In considering claim 9, Clynes further discloses that the means for routing the media file to the modifying means includes routing the media file through the routing means a plurality of times (col. 5, lines 62-67, wherein the user can “change [portions of the microscore] again, and each time listen to the new version”).

In considering claims 10, Clynes further discloses that the host computer is adapted to receive a video file (col. 6, lines 46-48, “video program”).

In considering claims 11, Clynes further discloses that the host computer is adapted to receive an audio file (col. 7, lines 24-25, “sound file”).

In considering claims 12, Clynes further discloses that the host computer is adapted to receive a music notation file (col. 4, lines 61-67, "microscore").

In considering claim 14, Clynes discloses a system comprising:

A memory for storing a media file ("central storage");

A personal communication device ("subscriber post"), said device having access to said memory;

A host computer ("server 15"; col. 4, line 18);

A network ("network") to allow communication between the host and the personal communication device (col. 5, lines 10-20; col. 6, lines 40-41, wherein the user creates the microscore and sends it to the central station to be stored);

Means accessible to the host computer for transforming the media file, means for routing the media file to the transforming means, and means for selecting one of a predetermined plurality of transformations to be performed by the transforming means (col. 7, lines 1-29; wherein the host transforms the score into a music file at a predetermined sampling rate, and can additionally convert it into a sound file for storing).

In considering claim 17, Clynes further discloses that the means for selecting a transformation comprises receiving a control signal from said host computer and means for sending multiple outputs to the transforming means (col. 7, lines 1-29).

2. Claims 1-3, 5, 8, 9, 11, 12, 14, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Sung et al. (U.S. Patent No. 6,423,893).

In considering claim 1, Sung discloses a system comprising:

A memory (inherent) for storing a media file; a host computer ("server 15"); and a personal communication device ("client computer 10"), said personal communication device having access to said memory and said personal communication device being adapted to transmit the media file to said host computer (col. 3, lines 60-63; col. 4, lines 31-35; col. 5, lines 4-10, wherein a user at a client creates a file and stores it at the server);

Means accessible to said host computer for modifying the media file (col. 3, line 34, "update" the information; col. 8, lines 13-34, wherein a browser web application is used to modify the media file);

Means for storing the modified media file (col. 3, lines 62-63);

Means for routing the media file to the modifying means (col. 8, lines 36-44, wherein the server returns MIDI or digital audio data to the author's browser); and

Means for selecting one of a predetermined plurality of modifications to be performed by the modifying means (col. 7, lines 46-61; col. 8 lines 13-34, wherein the predetermined modifications include "pick, hammer-on, slide, or other guitar-related techniques," as well as additional modifications, such as chords, measures, volumes, and others).

In considering claim 2, Sung further discloses that the host computer is adapted to transmit information to the personal communication device (col. 5, lines 9-10).

In considering claim 3, Sung further discloses that the host computer is adapted to receive the media file from said personal communication device over the Internet (col. 3, lines 60-63).

In considering claim 5, Sung further discloses that the host computer is adapted to receive a media file that is any of a plurality of predetermined formats (col. 4, lines 35-40, "(1) a solo musical instrument passage; (2) a musical ensemble arrangement; (3) a musical arrangement template; or (4) explanatory text or HTML"; col. 6, lines 11-29, "visual or aural representations," "binary digital audio data or MIDI").

In considering claim 8, Sung further discloses that the means for selecting a modification comprises receiving a control signal from said host computer and means for sending multiple outputs to the modifying means (col. 4, lines 50-65, wherein the server sends preexisting material and meta-data to the client so the client can modify the file).

In considering claim 9, Sung further discloses that the means for routing the media file to the modifying means includes routing the media file through the routing means a plurality of times (col. 5, lines 13-16; "reiterate this process of refining any of

these four types of information using the appropriate temporary web application 22 as often as necessary”).

In considering claim 11, Sung further discloses that the host computer is adapted to receive a media file that is an audio file (col. 6, lines 11-22, “MIDI” file).

In considering claims 12, Sung further discloses that the host computer is adapted to receive a music notation file (col. 4, lines 35-40).

In considering claim 14, Sung discloses a system comprising:

A memory (inherent) for storing a media file (col. 3, lines 62-63);

A personal communication device (“client computer 10”), said device having access to said memory (col. 4, line 17);

A host computer (“server 15”; col. 4, line 18);

A network (“Internet”) to allow communication between the host and the personal communication device (col. 4, line 18);

Means accessible to the host computer for transforming the media file, means for routing the media file to the transforming means, and means for selecting one of a predetermined plurality of transformations to be performed by the transforming means (col. 8, lines 34-43, wherein the file is routed from the client to the server, and the server transforms the file into one of a plurality of formats (i.e. a MIDI file or a digital audio format).

In considering claim 17, Sung further discloses that the means for selecting a transformation comprises receiving a control signal from said host computer and means for sending multiple outputs to the transforming means (col. 8, lines 34-43).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 4, 6, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clynes, in view of what was well known in the art at the time the invention was made.

In considering claims 3 and 4, although the system taught by Clynes discloses the use of a TV network to connect the client and server computers, it fails to disclose the use of an Internet or a private network. Nonetheless, Examiner takes official notice that the use of the Internet and/or a private network for accessing remote data is well known in the networking art. Thus, given such knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of implementing the network system taught by Clynes either on an Internet to extend accessibility to all users worldwide, or on a private network to restrict accessibility to

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only a select few. Therefore, it would have been obvious to implement the system taught by Clynes over an Internet or private network.

In considering claims, 6 and 15, Clynes further fails to disclose that the modifying/transforming means includes a patchbay and media interface device. Nonetheless, the use of patchbay and media interface devices to allow modification or transformation to a media file is well known, as admitted by Applicant in Applicant's application (see p. 6, lines 14-21, describing the use of the Midiman Digipatch 12 x 6 patchbay available from Midiman to make modifications to media files, "as is known to those of ordinary skill in the art"). Therefore, it would have been obvious to a person having ordinary skill in the art to use conventional means to convert the files, to avoid the time and effort required to build an entirely new program that performs the same function.

4. Claims 4, 6, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung.

In considering claim 4, although the system taught by Sung discloses the use of the Internet to connect the client and server computers, it fails to disclose the use of a private network. Nonetheless, Examiner takes official notice that the use of a private network for accessing remote data is well known in the networking art. Thus, given such knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of implementing the network system taught by Sung on

a private network, to restrict accessibility to only a select few. Therefore, it would have been obvious to implement the system taught by Sung over a private network.

In considering claims, 6 and 15, Sung further fails to disclose that the modifying/transforming means includes a patchbay and media interface device. Nonetheless, the use of patchbay and media interface devices to allow modification or transformation to a media file is well known, as admitted by Applicant in Applicant's application (see p. 6, lines 14-21, describing the use of the Midiman Digipatch 12 x 6 patchbay available from Midiman to make modifications to media files, "as is known to those of ordinary skill in the art"). Therefore, it would have been obvious to a person having ordinary skill in the art to use conventional means to convert the files, to avoid the time and effort required to build an entirely new interface that performs the same function.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Bradley Edilman

BE
December 29, 2003